

# REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims to define the invention in clearer form and to distinguish patentably from the prior art.

Thus, applicant has responded to each of the above objections raised by the Examiner in relation to the claims with the aim of avoiding those objections.

Applicant has also amended the specification including the title of the invention as written in the specification, the Abstract, as well as the objections to the expression two-cylinder telescoping leg at several places in the specification. Also included is the defining of the sealed lip as comprising an elastically tensioned ring with a more or less circular wall cross-section and the sealing lip 17.

With respect to the prior art, the British reference patent to GB 211 5903 discloses a check-valve arrangement 19, 20. However, applicant's check-valve arrangement has a very lower axial height than what is disclosed in the British reference patent. The reason why a much lower axial space is sufficient in applicant's invention, compared to the British reference patent, results from the structural difference in the seal of applicant's invention from that of the British reference patent.

In the British reference patent, the check-valve 19, 20, for example, are entirely different than in applicant's invention. The sealing lip 20 in this construction, lies against a sealing surface that extends in axial direction, namely at the cylindrical inner wall of the collar 11 on the rod guiding body 6. To construct this sealing surface, as disclosed in the British reference patent, it is necessary to have a significantly larger space in the axial direction.

In contrast to the British reference patent, the sealing surface in applicant's invention lies against the sealing lip 17 formed by the conical surface 18. The conical surface 18

extends from the lower lying channel 22 in essential radial direction so that it is not necessary in applicant's invention to provide any additional space in axial direction for the construction of the sealing surface. This structural solution according to applicant's invention is thereby a significant space saver and requires substantially less material for the rod guiding element than the arrangement disclosed in the British patent.

The Examiner has also noted that the sealing elements 19, 20 have an entirely different form than what is provided by applicant's invention with the sealing 16 and the sealing lip 17. Aside from that, however, it is also essential that the construction of the rod guide element in applicant's invention is entirely different from that provided in the British reference patent. Both elements, namely the rod guide and the seal function directly together so that it is essential to provide the sealing surface 18 relative to the seal 16 and the sealing lip 17 as in applicant's invention.

In the Office Action on page 4, paragraph 2, the Examiner considers that the notch 16 in the British reference patent is comparable with the flow-through recess 22 in applicant's invention. The Examiner argues that it is possible to arrive at applicant's invention as defined in claim 5, when the seal 19, 20 of the British reference patent is simply replaced by the seal 20 from the reference patent to the de Baan. However, this is in error because the interchange of the sealing surface with the seal in the British reference patent functions together always still in axial direction directed to the outside and a large axial space is required for this purpose.

Furthermore, an interchange of the seal 19, 20 of the British reference patent with the seal 20 of de Baan will not lead to the subject matter of applicant's invention.

Applicant has amended the base claim 5, at its end, to define that the sealing surface 18 is in the form of a conical

surface which extends from the flow-through recess 22 radially towards the outside. This feature is particularly disclosed in Figure 2 and in the corresponding description in applicant's specification. With this limitation in applicant's claim 5, this claim differs even further from the British reference patent because the sealing surface there is not conical, but is instead cylindrical, and it extends also not radially outward, but extends instead axially upward.

With respect to the reference patent to de Baan (US 4,428,566), an essential difference between this reference and applicant's invention is that this reference does not provide a channel beneath the seal 20 in the region of the sealing seat of the seal 20. In this patent to de Baan, the seal 20 is seated on an axially upwardly open groove 7' as described in column 3, lines 64-65 in this patent. In contrast thereto, applicant's invention provides a channel 22 in the form of the flow-through recess beneath the seal 16, whereby this flow-through recess is formed in the sealing seat beneath the seal 16, as defined in claim 5 of applicant.

Such a channel or flow-through recess 22 is not at all provided or anticipated in the reference patent to de Baan.

A further essential difference between the reference patent to de Bann is that the seal 20 there has no sealing lip 17. Instead, this reference exhibits a simple O-ring. The seal according to de Baan is thereby not at all adapted with a conical surface 18 to function in the sense of applicant's invention.

It is essential to note, therefore, that even when the seal 19, 20 of the British reference is replaced with the seal 20 of de Baan, then the seal 20 would not at all seal with the rod guide element 6 of the British patent and would not be effective with that British patent. With such a combination of references, therefore, no functional seal is obtained. As a

result, a person skilled in the art would not carry out such a combination.

It is submitted that the preceding combination of references suggested by the Examiner corresponds to unpermissible hindsight consideration or ex post facto analysis. Thus, a person skilled in the art would not be urged to combine these references and even when he might combine these references, then applicant's invention would not be arrived at.

In view thereof, applicant's invention is a novel arrangement over the prior art.

Since the claims in the application define clearly the differences between applicant's invention and the prior art, it is believed that the claims should be found allowable.

The Examiner's attention is respectfully directed to the Court decision in the case of *Bisley* (94 U.S.P.Q. 80, 86) in which it was decided that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

In the case of *ex parte Chicago Rawhide Manufacturing Company* (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a

finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

Furthermore, in *The Standard Oil Company vs. American Cyanamid Company* (227 U.S.P.Q. 293), the court ruled here that the issue of obviousness is determined entirely with reference to a hypothetical person having ordinary skill in the art. It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventor's, as a class, according to the concepts underlying the constitution and the statutes that have created the patent system, possess something that sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under 35 U.S.C. 103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelation of references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive systematic research or by extraordinary insight; it makes no difference which.

In the case of *Uniroyal Inc. versus Rudkin-Wiley Corporation* (5 U.S.P.Q.2d 1434), the Court decided that when prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must

suggest the desirability, and thus the obviousness of making the combination.

The preceding decision is reinforced by *In re Dow Chemical Company* (5 U.S.P.Q.2d 1529), in which the Court ruled that when most technological advance is the fruit of methodical persistent investigation, as is recognized in 35 U.S.C. §103. The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

Furthermore, in the case of *United Merchants and Manufacturers Incorporated versus Ladd* (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device and with advantage of hindsight, one might offhandedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the reference discloses or suggests the concept which is the crux of the invention.

In the case of *Ex parte Fleischmann* (157 U.S.P.Q. 155), the Patent Office Board of Appeals ruled that while it might be possible to select features from secondary references and mechanically combine them with primary reference to arrive at applicant's claim combination, there is no basis for making such combination disclosed or suggested in references; only applicant's specification suggests any reasons for combining references; under 35 U.S.C. 103, that does not constitute a bar.

In the case of *Panduit Corporation v. Burndy Corporation* (180 U.S.P.Q. 498), the District court ruled that inquiry into patentability must be directed towards subject matter as a whole and not to elements of combination and their individual novelty; combination which results in a more facile, economical, or